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TO : Commissioner for Patents
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FROM : Oleg F. Kaplun, Esq. (Reg. No. 45,559) of Fay Kaplun & Marcin, LLP)

DATE : August 9, 2006

SUBJECT : U.S. Patent Appln. Serial No. 09/739,475
for *Calender Software Application with Personal and Historical Data*
Phillips Ref.: US000349

NUMBER OF PAGES INCLUDING COVER : 23

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Attorney Docket No. 40160/00401

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s) : Eshelman et al.
Serial No. : 09/739,475
Filing Date : December 18, 2000
For : Calender Software Application with Personal and historical Data
Group Art Unit: : 2165
Examiner : Hassan Mahmoudi

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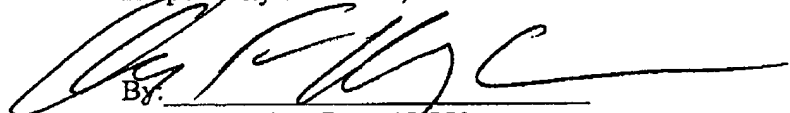
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By: Oleg F. Kaplun, (Reg. No. 45,559)	Date: August 9, 2006

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In response to the Notification of Non-Compliant Appeal Brief mailed July 12, 2006, transmitted herewith please find a copy of a revised Appeal Brief for filing in the above-identified application. No fees are believed to be required. The Commissioner is hereby authorized to charge the **Deposit Account of Fay Kaplun & Marcin, LLP NO. 50-1492** for additional required fees. A copy of the paper is enclosed for that purpose.

Dated: August 9, 2006

Respectfully submitted,

By: 
Oleg F. Kaplun, Reg. 45,559

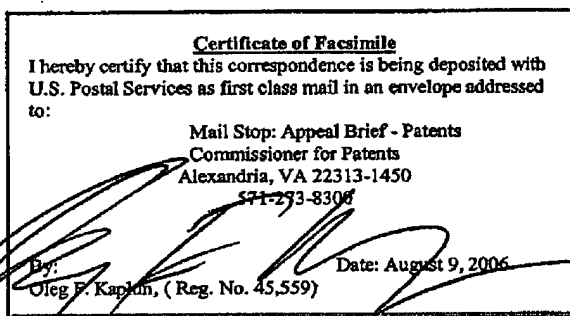
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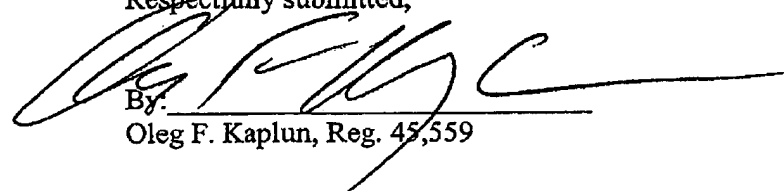


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[US000349]

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
Eshelman et al.)	
)	
Serial No.: 09/739,475)	Group Art Unit: 2165
)	
Filed: December 18, 2000)	Examiner: Hassan Mahmoudi
)	
For: CALENDAR SOFTWARE)	Board of Patent Appeals and
APPLICATION WITH PERSONAL)	Interferences
AND HISTORICAL DATA)	

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

In support of the Notice of Appeal filed on February 15, 2006, in response to the Notice of Non-Compliant Appeal Brief mailed on July 12, 2006, and pursuant to 37 C.F.R. § 41.37, Appellants present their appeal brief in the above-captioned application.

This is an appeal to the Board of Patent Appeals and Interferences from the Examiner's rejection of claims 1-6, 10, 14-18, the claims having been, at least, twice rejected. Claims 7-9 and 11-13 have been allowed in the November 15, 2005 Office Action. Claim 2 is withdrawn. The appealed claims are set forth in the attached Claims Appendix.

1. Real Party in Interest

This application is assigned to Philips Electronics North America Corp., the real party in interest.

2. Related Appeals and Interferences

There are no other appeals or interferences which would directly affect, be directly affected, or have a bearing on the instant appeal.

3. Status of the Claims

Claims 1-6, 10, and 14-18 have been rejected. Claims 7-9 and 11-13 have been allowed. Claim 2 is withdrawn. The rejection of claims 1, 3-6, 10, and 14-18 are being appealed.

4. Status of Amendments

All amendments submitted by Appellants have been entered.

5. Summary of Claimed Subject Matter

The present invention, recited in an independent claim 1, relates to a method 1 of generating a diary record. Specifically, an audio 7, video 6, or text data 9 is classified 36 and generates an indicator 65 of an event that is unrelated to a calendar application. (See Specification, p. 9, l. 22 – p. 10, l. 21; Fig. 2) (also See *Id.*, p. 11, ll. 6-10). A user is prompted by a calendar application 94 to enter data 70 relating to an event for incorporation in an archive personal to the user which is then accepted. (See Specification, p. 9, l. 22 – p. 10, l. 21; Fig. 2). A record is added 80 to an archive of historical records 95 that includes data resulting from the classification and accepting from the prompt. (See *Id.*, p. 11, ll. 1-6; Fig. 2).

The present invention, recited in an independent claim 6, also relates to another method 2 of generating a diary record. Specifically, data is accepted 45 to make a new record 80 in a calendar application 94. (See *Id.*, p. 11, ll. 12-16; Fig. 2). A user is prompted to provide greater detail 55 in an event other than the time of occurrence. (See *Id.*, p. 12, ll. 9-17; Fig. 2). A diary record 80 is automatically generated 75 responsive to the prior steps. (See *Id.*, p. 10, l. 22 – p. 11, l. 1; Fig. 2).

The present invention, recited in an independent claim 10, also relates to a third method 3 of generating a diary record. Specifically, a passage of time 30 for an entry of a record into a diary database or a time of day 30 is detected. (See Id., p. 11, ll. 12-16; Fig. 2). A user is prompted to enter 35 a diary entry responsive to the detection. (See Id., p. 12, ll. 9-17; Fig. 2). Data is accepted to form a new record 75 in a diary. (See Id., p. 10, l. 22 – p. 11, l. 1; Fig. 2). A new record is added 80 responsive to a result of accepting the data. (See Id., p. 10, l. 22 – p. 11, l. 1; Fig. 2).

The present invention, recited in an independent claim 14, also relates to a fourth method 4 of generating a diary record. Specifically, current events 85 or historical data 95 from an external data resource is extracted. (also See Id., p. 11, ll. 6-10; Fig. 2). Data descriptive of an appointment and an event of the current events is accepted to be included 40 in a diary database. (See Specification, p. 9, l. 22 – p. 10, l. 21; Fig. 2). The data resulting from the extracting and accepting is added 80 to the diary database. (See Id., p. 10, l. 22 – p. 11, l. 1; Fig. 2).

The present invention, recited in an independent claim 17, also relates to a fifth method 5 of generating a diary record. Specifically, user input data descriptive of personal events 36 to be recorded in a diary database is accepted. (See Id., p. 11, ll. 12-16; Fig. 2). The states, events, or moods of a user or user's environment is sensed and classified 36. (See Id., p. 14, l. 23 – p. 15, l. 15; Fig. 2). An index responsive to the sensing is generated 37. (See Id., p. 15, l. 20 – p. 17, l. 3; Fig. 2). The inputs are added 80 into the diary database. (See Id., p. 10, l. 22 – p. 11, l. 1; Fig. 2).

The present invention, recited in an independent claim 18, also relates to a data medium having instruction thereon for implementing a method for generating a diary record. Specifically, user input data 305, 160, 112, 140 descriptive of personal events to be recorded in a diary database 100 is accepted. (See Id., p. 11, ll. 12-16; Fig. 1). The states, events, or moods of a user or user's environment is sensed and classified 36. An index responsive to the sensing is generated 37. (See Id., p. 15, l. 20 – p. 17, l. 3; Fig. 2). The inputs are added into the diary database 100. (See Id., p. 10, l. 22 – p. 11, l. 1; Fig. 1).

6. Grounds of Rejection to be Reviewed on Appeal

I. Whether claims 1-4, 10, and 14-16 are unpatentable under 35 U.S.C. §

103(a) over U.S. Patent No. 6,471,449 (Blandford) in view of U.S. Pub. No. 2001/0027446 (Metcalf).

II. Whether claim 5 is unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,471,449 (Blandford) in view of U.S. Pub. No. 2001/0027446 (Metcalf) and further in view of U.S. Pub. No. 2002/0005865 (Hayes-Roth).

III. Whether claim 6 is unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,471,449 (Blandford) in view of U.S. Pub. No. 2001/0027446 (Metcalf) and further in view of U.S. Pub. No. 2001/0049617 (Berenson).

IV. Whether claims 17-18 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,471,449 (Blandford) in view of U.S. Pub. No. 2002/0005865 (Hayes-Roth).

7. Argument

I. The Rejection of Claims 1, 3-4, 10, and 14-16 Under 35 U.S.C. § 103(a) as Being Obvious Over Blandford in view of Metcalfe Should Be Reversed.

A. The Examiner's Rejection

In the Office Action, the Examiner rejected claims 1, 3-4, 10, and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Blandford in view of Metcalfe. (*See* 11/15/05 *Office Action*, p. 3, ll. 18-20).

Blandford is directed to a computer diary that archives a diary entry by creating, time stamping, authenticating and permanently storing a reference data block along with each diary entry. The manner that the entries are archived allows for a stringent method to modify and an easy method to authenticate. (*See* Blandford, abstract). Blandford may accept data from a computer via a communications port. (*See Id.*, col. 15, l. 66 – col. 16, l. 1). If there is a match between an original entry and a discrepancy such as an unauthorized modification, then an archive function may be called. (*See Id.*, col. 14, ll. 30-42). If there is a match between a checksum and a master flag (e.g., master password), then a user may archive the entry. (*See Id.*, col. 15, ll. 11-15).

Metcalfe is directed to an electronic system for regulating activity that includes a standard user interface that requires all information presented in the system to be formatted in a standard manner that is designed to achieve results. (See Metcalfe, abstract). The system uses several levels of interfaces, in particular the secondary interface that prompts users to input information in specific fields and formats. (See Id., p. 4, ¶ 35). The purpose of the interface is to gather enough information that is subjective to a user in order to achieve the ultimate goal of the system (*i.e.*, solve problems associated with currently trying to do business on the Internet). (See Id., p. 4, ¶ 36-39).

B. The Cited Patents Do Not Disclose Adding a Record to a Database Defining the Historical Record That Includes Data from the Step of Classifying and Data From the Step of Accepting as Recited in Claim 1.

The Examiner contends that Blandford teaches “adding a record to a database defining the historical record including at least one data resulting from the step of classifying and data resulting from the step of accepting.” (See 11/15/05 Office Action, p. 3, l. 21 – p. 4, l. 5).

Appellants respectfully submit that Blandford does not disclose adding a record to a database defining the historical record that includes data from the step of classifying and data from the step of accepting. The archiving method disclosed in Blandford, instead, matches a prior archiving with the present archiving. (See Id., col. 14, ll. 30-42). The archiving method also discloses a matching of a checksum, which is simply an error detector, and a master flag, which is simply a user password. (See Blandford, col. 15, ll. 11-15).

In contrast, the present application discloses and claims an archiving when the historical data includes data resulting from the classifying and the data resulting from the accepting. That is, Blandford archives either a matching with respect to some form of time or authentication whereas the present invention matches data resulting from a different type of entry, namely from the steps of classifying and accepting which entail an objective/subjective input match. Thus, it is respectfully submitted that neither Blandford nor Metcalfe, either alone or in combination, discloses or suggests “adding a record to a database defining said historical record including data resulting from said step of classifying and data resulting from said step of accepting,” as recited in claim 1.

C. The Cited Patents Do Not Disclose an Event Being Unrelated to a Calendar/Diary Application as Recited in Claim 1.

The Examiner has correctly stated that Blandford does not teach classifying at least one of audio, video, and text input to a computer and generating an indicator of an event responsively thereto, said event being unrelated to a calendar/diary application, and prompting a user, by a calendar/diary application, to enter data relating to the event for incorporation in a historical record of events pertaining to a user. The Examiner has attempted to cure this deficiency with Metcalfe. (See 11/15/05 Office Action, p. 4, ll. 12-16).

Metcalfe discusses subjective input in their tiers of interfaces. Specifically, Metcalfe includes steps of prompting a user for and receiving from the user who/what information relating to the activity, why/how information relating to the activity, and where/when information relating to the activity. (See Metcalfe, p. 3, ¶ 25). All of these inputs require some subjective information that pertains, in particular, to the user. This is markedly different from the recited "said event being *unrelated* to a calendar/diary application," because the standard with regards to the event is objective. That is, in the classifying step, the event is unrelated and independent of the user until, after the prompting, there is a match between the data that results from the classifying and the data that results from the prompting. Thus, it is respectfully submitted that neither Blandford nor Metcalfe, either alone or in combination, disclose or suggest classifying and generating an indicator of an event, "said event being unrelated to a calendar/diary application," and "adding a record to a database defining said historical record including data resulting from said step of classifying and data resulting from said step of accepting," as recited in claim 1.

Claims 3-4 depend from independent claim 1. Therefore, dependent claims 3-4 include all of the elements and limitations of its respective independent claim. Thus, it is respectfully submitted that neither Blandford nor Metcalfe, either alone or in combination, disclose or suggest classifying and generating an indicator of an event, "said event being unrelated to a calendar/diary application," and "adding a record to a database defining said historical record including data resulting from said step of classifying and data resulting from said step of accepting," as recited in claim 1.

D. The Cited Patents Do Not Disclose Prompting a User to Enter a Diary Entry Responsively to Said Step of Detecting as Recited in Claim 10.

The Examiner has correctly stated that Blandford does not teach prompting a user to enter a diary entry responsively to the step of detecting. The Examiner has attempted to cure this deficiency with Metcalfe. (See 11/15/05 Office Action, p. 6, ll. 10-14).

Appellants respectfully submit that Metcalfe does not disclose prompting a user to enter a diary entry responsively to the step of detecting. Metcalfe merely "prompts the user to enter information relative to the time or times when the transaction is performed." (See Metcalfe, p. 5, ¶ 39). In other words, Metcalfe simply records proposed or actual times to reflect facts and propositions. (See *Id.*). In contrast, the present application discloses and claims prompting a user to enter a diary entry *responsively* to the step of detecting, where the said step of detecting involves detecting a passage of time since an entry of a record into a diary database or a time of day. Thus, it is respectfully submitted that neither Blandford nor Metcalfe, either alone or in combination, disclose or suggest "prompting a user to enter a diary entry responsively to the step of detecting," as recited in claim 10.

E. The Cited Patents Do Not Disclose Adding Data Resulting From Said Step of Extracting to Data Resulting From Said Step of Accepting to Said Diary Database as Recited in Claim 14.

The Examiner has correctly stated that Blandford does not teach accepting data descriptive of at least one of an appointment and an event for inclusion in a diary database. The Examiner has attempted to cure this deficiency with Metcalfe.

Appellants respectfully submit that Metcalfe merely describes the primary and secondary interface as described above and that information gathered by the system may be utilized to simplify the creation of features such as a diary or address book. (See Metcalfe, p. 5, ¶ 39-40, and p. 7, ¶ 55). In addition, as discussed above, Metcalfe requires subjective input from the user. As recited in claim 14, "extracting current events or historical data from an external data resource" implies the objective requirement discussed above. In contrast, the diary of Metcalfe is a calendar-based secondary interface designed to maintain the record of times when events of any description occurred or are scheduled to occur, the events being personal to the user. (See *Id.*, p. 7, ¶ 55). Thus, it is respectfully submitted that neither Blandford nor Metcalfe,

either alone or in combination, disclose or suggest “adding data resulting from said step of extracting to data resulting from said step of accepting to said diary database,” as recited in claim 14.

Claims 15-16 depend from independent claim 14. Therefore, dependent claims 15-16 include all of the elements and limitations of its respective independent claim. Thus, it is respectfully submitted that neither Blandford nor Metcalfe, either alone or in combination, disclose or suggest “adding data resulting from said step of extracting to data resulting from said step of accepting to said diary database,” as recited in claim 14.

F. The Cited Patents Describe No Motivation to Combine Such Technologies and Would Not Have Been Obvious to One Skilled in the Art.

In addition to Blandford and Metcalfe not teaching the above recited limitations, Appellants also maintain that it would not have been obvious to a person having ordinary skill in the art to modify Blandford by the teaching of Metcalfe. As discussed above, Blandford pertains to a computer diary that has several levels of security, even to the user. Metcalfe, on the other hand, pertains to an entirely different archiving of information, namely gathering of information to conduct a business on the Internet (e.g., keeping business records). The mere similarity that both inventions deal with computers and archiving should not preclude the present application since such a combination would not have been obvious to one skilled in the art.

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. In re Oetiker, 977 F. 2d 1443, 1445, 24 USPQ2d 1442, 1444 (Fed. Cir. 1992). See also In re Piasecki, 745 F. 2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art of knowledge generally available to one of ordinary skill in the art suggest the claimed subject matter. In re Fine, 837 F. 2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

When determining obviousness, “[t]he factual inquiry whether to combine references must be through and searching.” In re Lee, 277 F. 3d 1338, 1343, 61 USPQ 1430, 1433 (Fed. Cir. 2002), citing McGinley v. Franklin Sports, Inc., 262 F. 3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). “It must be based on objective evidence of record.” Id. “Broad conclusory statements regarding the teaching of multiple references, standing alone, are

not 'evidence.'" In re Dembiczak, 175 F. 3d 994, 999, 50 USPQ2d 1614, 1617. "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." Dembiczak, 175 F. 3d at 1000, 50 USPQ2d at 1617, citing McElmurry v. Ark. Power & Light Co., 995 F. 2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

The suggestion on the Office Action that the combinations of prior art references "would be obvious to one having ordinary skill in the art..." is respectfully refuted. One may not utilize the teaching of the present application as a road map to pick and choose amongst prior art references for the purposes of attempting to arrive at the presently disclosed invention. The Federal Circuit has identified three possible sources for motivation to combine references including the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skill in the art. (See, In re Rouffet, U. S. Court of Appeals Federal Circuit, U.S.P.Q. 2d 1453, 1458.) There must be a specific principle that would motivate a skilled artisan, with no knowledge of the present invention, to combine the prior art as suggested in the Office Action. The use of hindsight in the selection of references is forbidden in comprising the case of obviousness. Lacking a motivation to combine references, a proper case of obviousness is not shown (see, In re Rouffet, 1458).

The U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") restated the legal test applicable to rejections under 35 U.S.C. §103 (a) in the In re Rouffet holding. The Court stated:

[V]irtually all [inventors] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting parents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention. This court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board (of Appeals) did not, however, explain what specific understanding of technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness contract the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U. S. C. §103 (a). In this case the Court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in details the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, not does the Board make specific—or even inferential—findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper analysis.

In re Dembiczak, 50USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both In re Rouffet and In re Dembiczak it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them.

The Examiner's reasoning for the motivation, namely, that those skilled in the art would have been motivated to combine Blandford with the other prior art, could only have been made with hind sight based on the teaching of the present disclosure. The Examiner's reasoning for the motivation for combining the references is nowhere recognized in the prior art nor does the Examiner attempt to make any showing that the art recognized such problems.

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-Site Corp. v. VSI International Inc., 174 F. 3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Thus, Appellants again respectfully submit that the Examiner has used impermissible hindsight to reject claims 1, 3-6, 10, and 14-18 under 35 U.S.C. §103 (a). As discussed above, the Federal Circuit in In re Rouffet stated that virtually all inventions are combinations of old element. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat

patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Appellants respectfully submit that the Examiner has not met this burden.

The mere fact that the prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984), and In re Laskowski, 871 F. 2d 115, 117 (Fed. Cir. 1989).

The only suggestion that can be found anywhere for making these combinations appears to come from the present patent application itself.

In consideration of the use of improper hindsight for rendering a claim obvious in light of prior art, the Federal Circuit has stated that “to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge is to use the invention as a template for its own reconstruction – an illogical and inappropriate process by which to determine patentability.” (Sensonic, Inc. v. Aerosonic Corp., 81F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996). “To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against each teacher.” (In re Zurko, 111 F. 3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). A critical step is analyzing the patentability of claims pursuant to section 103 (a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited reference omitted).” (In re Kotzab, 208 F. 3d 1352, 54 USPQ2d 1308 (Fed. Cir. 1997).

Appellants respectfully maintain that there is no suggestion in the prior art references to make the combinations in the manner proposed by the Examiner to achieve the Appellants’ claimed invention.

Considering MPEP 2143, it is stated:

“THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE

CLAIMED INVENTION ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” And, “FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS... The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F. 2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)... Although a prior art device “ may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” 916 F.2d at 682, 16 USPQ2d at 1432.).” There is no such suggestion in either Blandford or Metcalfe that would justify such a combination.

It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the cited references, that none of the suggested combinations of prior art utilized to reject each of claims 1-4, 10, and 14-16 finds proper motivation for combination. Further, since the Examiner's rejections acknowledge that the prior art alone does not show the claimed features, it is respectfully submitted that claims 1-4, 10, and 14-16 are not obvious in light of the cited references.

II. The Rejection of claim 5 Under 35 U.S.C. § 103(a) as Being Obvious Over Blandford in view of Metcalfe and further in view Hayes-Roth Should Be Reversed.

A. The Examiner's Rejection

In the Office Action, the Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Blandford in view of Metcalfe further in view of Hayes-Roth. (See 11/15/05 *Office Action*, p. 8, ll. 5-8). Blandford and Metcalfe are discussed above.

Hayes-Roth is directed to interpret user inputs to generate a set of responses through automated means. (See Hayes-Roth, abstract). Hayes-Roth provides a means of anticipating an abstract structure of prospective interactions between agents and their users, defining localized contexts within that abstract structure, and allowing authors to create content

for each such localized context. (See Id., p. 1, ¶ 8).

B. The Cited Patents Do Not Disclose Adding a Record to a Database Defining the Historical Record That Includes Data from the Step of Classifying and Data From the Step of Accepting as Recited in Claim 1.

Claim 5 depends from independent claim 1. Therefore, dependent claim 5 includes all of the elements and limitations of its respective independent claim. Hayes-Roth does not cure the above described deficiencies of Blandford and Metcalfe. Thus, it is respectfully submitted that neither Blandford nor Metcalfe nor Hayes-Roth, either alone or in combination, disclose or suggest classifying and generating an indicator of an event, "said event being unrelated to a calendar/diary application," and "adding a record to a database defining said historical record including data resulting from said step of classifying and data resulting from said step of accepting," as recited in claim 1.

C. The Cited Patents Describe No Motivation to Combine Such Technologies and Would Not Have Been Obvious to One Skilled in the Art.

The state of the law as set forth by the Federal Circuit is discussed above. It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the cited references, that none of the suggested combinations of prior art utilized to reject claim 5 finds proper motivation for combination. Further, since the Examiner's rejections acknowledge that the prior art alone does not show the claimed features, it is respectfully submitted that claim 5 is not obvious in light of the cited references.

III. The Rejection of Claim 6 Under 35 U.S.C. § 103(a) as Being Obvious Over Blandford in view of Metcalfe further in view of Berenson Should Be Reversed.

A. The Examiner's Rejection

In the Office Action, the Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Blandford in view of Metcalfe further in view of Berenson. (See 11/15/05 *Office Action*, p. 9, ll. 1-3). Blandford and Metcalfe are discussed above.

Berenson is directed to an event scheduling system that allows users to request reminders of upcoming events over the Internet either by specifying the event to be reminded of or being reminded of events that meet a certain criteria. (See Berenson, abstract). The purpose of the system is to draw from various sources to remind a user of events defined by the user's interests. (See Id. p. 1, ¶ 17).

B. The Cited Patents Describe No Motivation to Combine Such Technologies and Would Not Have Been Obvious to One Skilled in the Art.

Appellants maintain the prior argument that it would not have been obvious to a person having ordinary skill in the art to modify Blandford by the teaching of Metcalfe further by the teaching of Berenson. As discussed above, Blandford pertains to a computer diary that has several levels of security, even to the user. Metcalfe, on the other hand, pertains to an entirely different archiving of information, namely gathering of information to conduct a business on the Internet (e.g., keeping business records). In addition, because Metcalfe pertains to conducting a business, criteria other than time of occurrence is naturally acceptable. On the other hand, because Blandford pertains to a computer diary where entries are earmarked specifically with time, it would not have been obvious to one skilled in the art to prompt a user for greater detail in an event defined by a record other than a time of occurrence, as recited in claim 6. The mere similarity that both inventions deal with computers and archiving should not preclude the present application since such a combination would not have been obvious to one skilled in the art.

The state of the law as set forth by the Federal Circuit is discussed above. It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the cited references, that none of the suggested combinations of prior art utilized to reject claim 6 finds proper motivation for combination. Further, since the Examiner's rejections acknowledge that the prior art alone does not show the claimed features, it is respectfully submitted that claim 6 is not obvious in light of the cited references.

IV. The Rejection of Claims 17-18 Under 35 U.S.C. § 103(a) as Being Obvious Over Blandford in view of Hayes-Roth Should Be Reversed.

A. The Examiner's Rejection

In the Office Action, the Examiner rejected claims 17-18 under 35 U.S.C. § 103(a) as being unpatentable over Blandford in view of Hayes-Roth. (See 11/15/05 *Office Action*, p. 10, ll. 16-17). Blandford and Hayes-Roth are discussed above.

B. The Cited Patents Describe No Motivation to Combine Such Technologies and Would Not Have Been Obvious to One Skilled in the Art.

Appellants maintain the prior argument that it would not have been obvious to a person having ordinary skill in the art to modify Blandford by the teaching of Hayes-Roth. As discussed above, Blandford pertains to a computer diary that has several levels of security, even to the user. Hayes-Roth, on the other hand, pertains to an entirely different computer technology that deals with emotion generating responses. It is respectfully submitted that merely sensing a mood of a user as claimed in Hayes-Roth is insufficient to satisfy the deficiencies of Blandford, specifically “sensing and classifying states, events or moods of a user or said user’s environment; generating an index responsive to said step of sensing; adding said index and said user input to said diary database,” as recited in claim 17. The mere coincidence that the combination of both inventions making the claims obvious should not preclude the present application since such a combination would not have been obvious to one skilled in the art.

The state of the law as set forth by the Federal Circuit is discussed above. It is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the Examiner’s lack of specificity with regard to the motivation to combine the cited references, that none of the suggested combinations of prior art utilized to reject each of claims 17 and 18 finds proper motivation for combination. Further, since the Examiner’s rejections acknowledge that the prior art alone does not show the claimed features, it is respectfully submitted that claims 17 and 18 are not obvious in light of the cited references.

8. Conclusions

For the reasons set forth above, Appellants respectfully request that the Board reverse the final rejection of the claim by the Examiner under 35 U.S.C. § 103(a), and indicate that claims 1, 3-6, 10, and 14-18 are allowable.

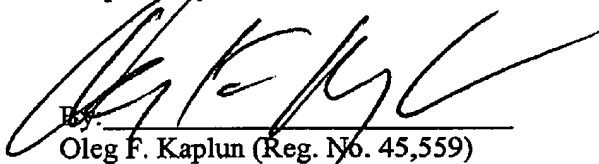
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Respectfully submitted,

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CLAIMS APPENDIX

1. A method of generating a diary record, comprising the steps of:
classifying at least one of audio, video, and text input to a computer and generating an indicator of an event responsively thereto;
said event being unrelated to a calendar/diary application;
prompting a user, by a calendar/diary application, to enter data relating to said event for incorporation in a historical record of events pertaining to a user;
accepting user input responsive to said step of prompting;
adding a record to a database defining said historical record including data resulting from said step of classifying and data resulting from said step of accepting.
3. A method as in claim 1, wherein said event includes writing an email letter.
4. A method as in claim 1, wherein said event includes writing a letter on a text application other than said calendar/diary application.
5. A method as in claim 1, wherein said event includes a change in a mood of said user.
6. A method of generating a diary record, comprising the steps of:
accepting data towards the making of a new record in a calendar application;
prompting a user for greater detail in an event defined by said record other than a time of occurrence;
automatically generating a diary record responsive to a result of said steps of accepting and prompting.
10. A method of generating a diary record, comprising the steps of:
detecting one of a passage of time since an entry of a record into a diary database and a time of day;
prompting a user to enter a diary entry responsively to said step of detecting;
accepting data to form a new record in a diary;

adding a new record responsive to a result of said step of accepting.

14. A method of generating a diary record, comprising the steps of:
 - extracting current events or historical data from an external data resource;
 - accepting data descriptive of an appointment and an event of the current events for inclusion in a diary database;
 - adding data resulting from said step of extracting to data resulting from said step of accepting to said diary database.
15. A method as in claim 14, wherein said step of adding includes accepting user input data indicative of instructions to modify said current events or historical data.
16. A method as in claim 14, wherein said step of adding includes correlating a date corresponding to said current events or historical data with a date diary data entered in said diary database.
17. A method of generating a diary record, comprising the steps of:
 - accepting user input data descriptive of personal events to be recorded in a diary database;
 - sensing and classifying states, events, or moods of a user or said user's environment;
 - generating an index responsive to said step of sensing;
 - adding said index and said user input to said diary database.
18. A data medium having instruction thereon for implementing a method for generating a diary record, comprising the steps of:
 - accepting user input data descriptive of personal events to be recorded in a diary database;
 - sensing and classifying states, events, or moods of a user or said user's environment;
 - generating an index responsive to said step of sensing;
 - adding said index and said user input to said diary database.

EVIDENCE APPENDIX

No evidence has been entered or relied upon in the present appeal.

RELATED PROCEEDING APPENDIX

No decisions have been rendered regarding the present appeal or any proceedings related thereto.